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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/351,399      | 07/13/1999  | AKIRA OGINO          | 450100-4982         | 9658             |

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/351,399

Applicant(s)

OGINO ET AL.

Examin r

Hyung S. Sough

Art Unit

2161

-- Th MAILING DATE of this communication app ars on the cover she t with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 6-12, 16-19, 25-31, 37-43, 47-50 and 56-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 13-15, 20-24, 32-36, 44-46 and 51-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_ .

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***Election/Restriction***

1. Applicants' election without traverse of species I, claims 1-5, 13-15, 20-24, 32-36, 44-46, and 51-55, in Paper No. 9 is acknowledged. Contrary to applicants' assertion, Figs. 1 and 3 are not the same species. More specifically, applicants' attention is directed the arrangement of "DECRYPTING UNIT" (122) and "DIGITAL-WATERMARK-INFORMATION DETECTING UNIT" (124), i.e., the flow of "Vm" in Fig 1 is different from the flow of "Vm" in Fig. 3. Likewise Figs. 4 and 5 are not the same species. If applicants still disagree with the Examiner's position, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

***Specification***

2. The disclosure is objected to because of the following informalities: It is not clear whether FIGS. 8 and 9 are prior art or not. More specifically, the detailed description of FIGS. 8 and 9 is in the "BACKGROUND OF THE INVENTION" and not in the "DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENTS". However, the specification does not clearly states whether FIGS. 8 and 9 are prior art or not.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 13, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-65662 (JP '662 hereinafter).

JP '662 discloses an information signal playback system having all of the features claimed: see an attached figure.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 15, 22, 32, 34, 44, 46, 51, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '662.

**Re claims 32, 44, and 51:** JP '662 does not explicitly disclose the claimed methods.

However, it would have been obvious in view of the disclosed apparatus.

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**Re claims 3, 15, 22, 34, 46, and 53:** JP '662 does not explicitly disclose the use of CSS system. However, CSS system is one of old and well-known recording and reproducing system and nothing unobvious is seen to have been involved simply having employed this well known system for an information signal playback system of the sort here involved.

7. Claims 2, 14, 21, 33, 45, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '662 in view Heemskerk (US PAT. 6,031,815).

JP '662 does not explicitly disclose that the information on copyright protection is media-type information indicating the type of the recording medium. However, Heemskerk teaches the use of information on copyright protection being media-type information indicating the type of the recording medium (e.g., col 1, line 63-col. 2, line 15) to better control a reproduction of the information. Thus, it would have been within the level of ordinary skill in the art to modify the apparatus and method of JP '662 by adopting the teaching of Heemskerk to provide better control of reproduction of the information to the claimed apparatus and method.

8. Claims 4, 5, 23, 24, 35, 36, 54, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '662 in view of Kato et al. (Kato hereinafter: US PAT. 6,301,663B1).

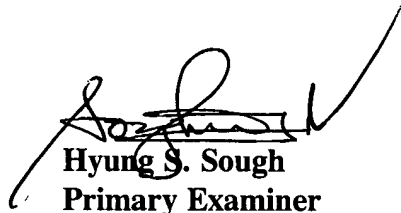
JP '662 does not explicitly disclose the use of digital-watermark information for the claimed apparatus and method. However, Kato teaches the use of encryption and digital watermark information with an encryption device to enhance a copy protection apparatus and method. Thus, it would have been obvious to one of ordinary skill in the art to modify the apparatus and method by adopting the teaching of Kato to enhance a copy protection apparatus and method.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

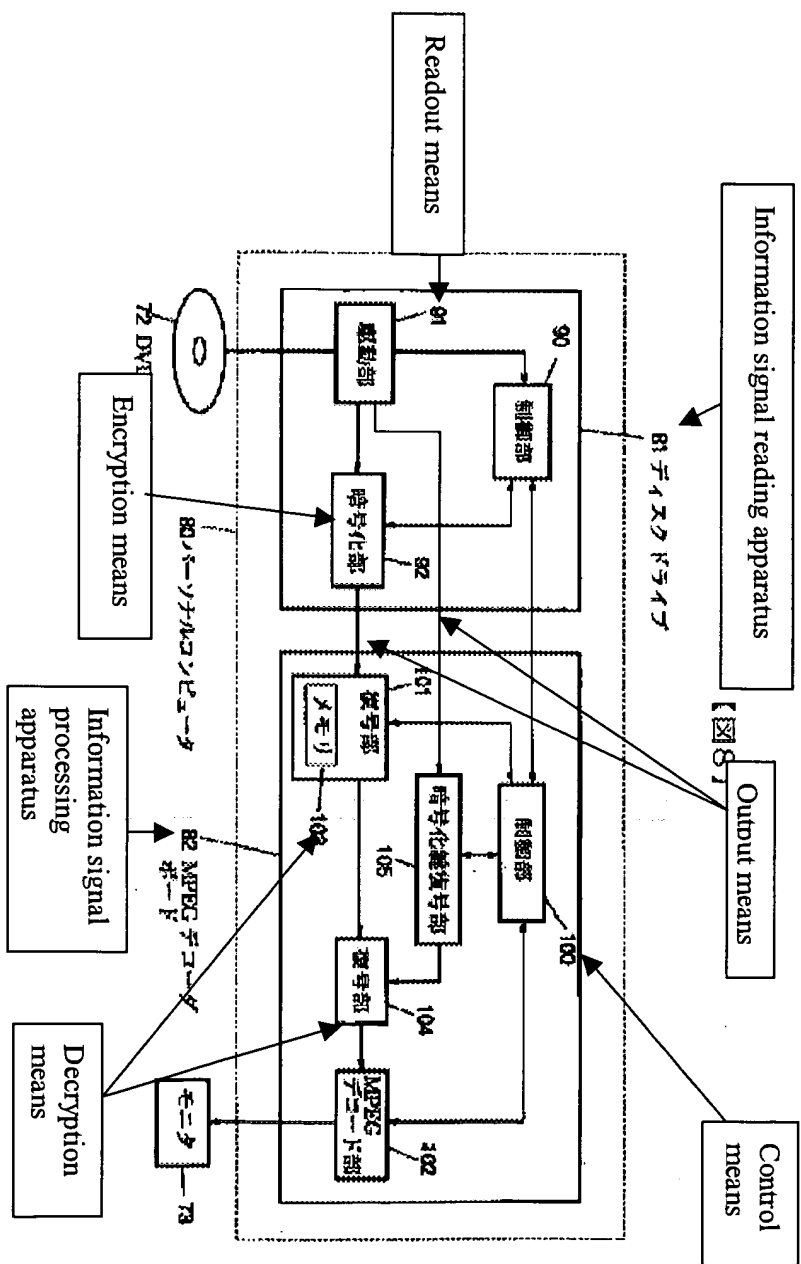
If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax numbers are (703) 746-7238 for After-final, (703) 746-7239 for Official, and (703) 746-7240 for Non-Official/Draft.



Hyung S. Sough  
Primary Examiner  
Art Unit 2161

shs  
March 10, 2002



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